



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,361	12/01/2000	Robert Bible, JR.	11298.4	4116

7590 04/13/2004

NEIL K. NYDEGGER
NYDEGGER & ASSOCIATES
348 Olive Street
San Diego, CA 92103

EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,361

Applicant(s)

BIBLE, ET AL.

Examiner

Jalatee Worjloh

Art Unit

3621

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 23, 2004 has been entered.
2. Claims 21-27 have been examined.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6226618 to Downs et al. in view of U.S. Publication No. 2002/0112171 to Ginter et al.

Downs et al. disclose encrypting said file (i.e. "secure container (SC)"), wherein at least a portion of the content is encrypted by the seller (i.e. "content provider") using a private key (i.e. "symmetric key"), wherein the overhead (i.e. "metadata") include the private key (i.e. "symmetric key") and the transaction agency (i.e. "clearinghouse") (see col. 18 table, steps 125-127), presenting said encrypted file on the Internet for transfer to the buyer (see col. 18 table, step 135), decrypting said file, wherein the buyer uses the private key (i.e. "symmetric key") to

Art Unit: 3621

decrypt the content and complete the transfer of the file to the buyer (see col. 19 table, steps 144-148). Also, see col. 89, claims 1, 3, and 4. Downs et al. do not expressly disclose sending a two-part file or using the public key to reveal the private key. Ginter et al. disclose sending a two-part file (i.e. “secure container”) and using the public key to reveal the private key (i.e. “decryption key”), see fig. 7, paragraphs [1056], lines 20-24 and [1194]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Downs et al. to include the step of sending a two-part file and using the public key to reveal the private key. One of ordinary skill in the art would have been motivated to do this because it provides secure delivery of the electronic content (see Downs et al., col. 3, lines 40-42).

Referring to claim 22, Downs et al. disclose the method wherein the overhead (i.e. “metadata”) is encrypted by the transaction agency (see col. 18 table, step 125).

Referring to claim 23, Downs et al. disclose the method wherein the overhead is encrypted by the seller (see col. 28, lines 7-9).

Referring to claim 24, Ginter et al. disclose the two-part file is periodically changed (see paragraph [2164]). That is, Ginter et al. teach “periodical publication”, which implies that the file is periodically changed. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Downs et al. to include the step wherein the file is periodically changed. One of ordinary skill in the art would have been motivated to do this because it provides additional security.

Referring to claim 25, Ginter et al. disclose the overhead (“permission record”) contains commercial material about said file, including pricing and payment terms (see paragraph [1903]).

Art Unit: 3621

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Downs et al. to include commercial material about said file within the overhead. One of ordinary skill in the art would have been motivated to do this because it provides detail information that may be necessary to the buyer.

Referring to claim 26, Ginter et al. disclose the overhead comprises a header containing clear-text advertising material about the content and informational material about the seller (see paragraph [2170]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Downs et al. to include a header containing clear-text advertising material about the content and informational material about the seller. One of ordinary skill in the art would have been motivated to do this because it provides detail information that may be necessary to the buyer.

Referring to claim 27, Downs et al. disclose the content includes work selected from a group consisting of books, documents, pamphlets, movies, songs, games, pictures and software (see col. 6, lines 45-84; col. 18 table, step 136).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft.

Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450***

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, V.A., Seventh floor receptionist.

April 5, 2004


**JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**